



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/642,622	08/18/2000	Ryukou Arisawa	32893	8248

116 7590 05/17/2004

PEARNE & GORDON LLP
1801 EAST 9TH STREET
SUITE 1200
CLEVELAND, OH 44114-3108

EXAMINER

GEREZGIHER, YEMANE M

ART UNIT	PAPER NUMBER
----------	--------------

2144

DATE MAILED: 05/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/642,622

Applicant(s)

ARISAWA ET AL.

Examiner

Yemane M Gerezgiher

Art Unit

2144

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 March 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 9.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. Amendment A, received on 03/11/2004 has been entered. Claims 1-5 are pending in this application.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hsu et al (U.S. Patent Number 6,587,684) hereinafter referred to as Hsu in view of Takagaki et al (Publication Number US 2002/0065066 A1) hereinafter referred to as Takagaki and further in view of Kondou et al (U.S. Patent Number 6,073,075) hereinafter referred to as Kondou.

Regarding claims 1-5, Hsu disclosed a digital wireless telephone system downloading software to a digital mobile station (cell phone) comprising a storage medium, where the system included a server having applications to be downloaded to the portable phone. Hsu disclosed mobile user sending request messages to a destination server (claim 3) to establish a session between the digital telephone and the server for downloading new and update software applications related to the digital telephone service. See abstract and Fig 7 and 9. Hsu disclosed a "digital wireless

telephone configured for recovering an executable program selected by the user and associated with digital telephone services from a stream of wireless data packets received from a digital wireless telephone network, and storing the executable program in a nonvolatile memory (claim 5) for execution by the digital wireless telephone where a digital wireless telephone is configured for sending selection inputs supplied by a user to a server via a digital wireless communications system, and receiving downloaded software from the server based on the selection inputs". See col.3, Lines 54-67. Hsu disclosed a portable phone downloading, storing application software in the storage medium of the portable phone and executing the multiple downloaded software which interact by exchanging network messages across API (application programming Interface). See col.4, Lines 17-54. Hsu showed a client browser executable by the portable telephone enabling the mobile phone user to navigate a network to select the downloading of different software applications as they are made available on the server that are executable by the digital portable telephone (see col.4, lines 55-67) such as operating system, cell processing software and many more applications selected based on the mobile user's desired selections. See col.5, Lines 1-20. Hsu substantially disclosed the invention as claimed. However, Hsu did not explicitly teach the downloaded data been an audio data (music data) and application software expressly to play music data on portable telephone and recording a history of the downloaded data items.

An artisan working with Hsu's invention related downloading information data and a plurality of software application to a mobile station from a remote server would have

been motivated to look for teachings that may have allowed a user to select or specify a music data to be downloaded and reproduced on the mobile station by selecting a music data from a large number of music data and to specify the reproduction order of the selected music data. In these arts, Takagaki disclosed a mobile communication apparatus and information providing system where a client with a mobile device downloading a music data from a remote server having therein a plurality of music data stored. Takagaki taught downloading a music data into the storage means of the mobile device, compressing the music data using different compression application techniques and reproducing high quality music on the mobile device. See ABSTRACT, Page 4, Section [0047] through Page 5. Takagaki substantially disclosed the claimed invention, but Takagaki was silent regarding recording a download history. However, as evidenced by the teachings of Kondou this feature was well known in the art at the time of the invention. Kondou taught recording a history of downloaded information. See Column 7, Line 60 through Column 8, Line 3.

Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to take the teachings of Takagaki related to downloading a music data from a remote server and reproducing a music data and have modified Hsu related to downloading data and software applications that are executable on the portable telephone in order for the user of the mobile communication to listen to a music data reproduced/recorded on the storage of the mobile station at a desired time offline. See ABSTRACT, Page 1, Section [0010] and Page 4, Section [0052]. It is respectfully submitted that it would have been obvious to one of ordinary skill in the art at the time

the invention was made to further take the teachings of Kondou related to recording or logging history of download information and have modified the already combined teachings of Takagaki and Hsu related to music recording or reproducing on a mobile device, because such a modification would help eliminate the waste of downloading the same information that may have been already downloaded on the mobile station. See Column 7, Line 60 through Column 8, Line 3.

Conclusion

4. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure.
 - a. Lin, Janette Chen et al (U.S. Patent Number 6,366,791) Entitled: *System and method for providing a musical ringing tone on mobile stations*
 - b. Valentine, Eric Lee et al. (U.S. Patent Number 6,018,654) Entitled: *Method and apparatus for downloading tones to mobile terminals*
5. Any inquiry concerning this communication or earlier communication from the examiner should be directed to Yemane Gerezgiher whose telephone number is 703-305-4874. The examiner can normally be reached on Monday- Friday from 9:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful. The examiner's supervisor, William Cuchlinski, can be reached at (703) 308-3873.

Yemane M. Gerezgiher
AU 2144

MARC D. THOMPSON
MARC THOMPSON
PRIMARY EXAMINER